

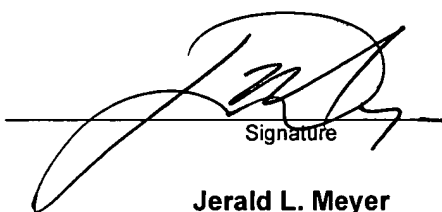
Doc Code: AP.PRE.REQ

PTO/SB/33 (01-09)

Approved for use through 02/28/2009. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 28864U	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] On _____ Signature _____ Typed or printed name _____	Application Number 10/665,511	Filed September 22, 2003	
	First Named Inventor Douglas A. BEIGEL		
	Art Unit 3715	Examiner Robert J. UTAMA	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>41,194</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <div style="text-align: right;"> _____ Signature Jerald L. Meyer Typed or printed name (703) 548- 6284 Telephone number April 1, 2009 Date</div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:
Douglas A. BEIGEL

Confirmation No.: 5823

Application No.: 10/665,511

Group Art Unit: 3715

Filed: September 22, 2003

Examiner: Robert J. UTAMA

For: **ONLINE SYSTEM AND METHOD FOR ASSESSING/CERTIFYING
COMPETENCIES AND COMPLIANCE**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW STATEMENT
ACCOMPANYING NOTICE OF APPEAL**

Mail Stop AF
P.O. Box 1450
Commissioner for Patents
Alexandria, VA 22313-1450

Dear Commissioner:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this Request. Further, this Request is being filed with a Notice of Appeal. The review is requested for the reasons stated herein.

1. Rejection of claims 1, 8, 11, 22, 25 and 26 under 35 U.S.C. § 102(b)

Applicant appeals the final rejection of claims 1, 8, 11, 22, 25 and 26 under 35 U.S.C. §102(b) as being unpatentable over Singer et al. ("Singer"). This rejection is improper since the Examiner refused to consider Applicant's evidence which clearly rebuts the anticipation rejection.

A. The Examiner Must Give Weight to *Intended Use* When Such Use Results In A Structural Difference

Applicant's claims recite that "assessment questions ask for information usable to determine if at least one organization meet the requirement for at least one compliance certification." In the Advisory Action, the Examiner indicates "[f]irstly, the disputed limitation can be interpreted as an intended use limitation. Secondly, the Singer reference provides an explicit teaching where the information gathered previously are used to determine if at least one organization meet the requirement for at least one compliance certification." Applicant respectfully submits that the

Examiner's understanding of the assessment questions, much less the assessment questions necessary to determine meeting the requirements for compliance certification, is not in accordance with those recited in the claims. The assessment questions asked to gauge whether an organization has met the requirements for compliance certification recited in the claims are designed based on the compliance certification the organization is trying to receive. The Examiner is not giving patentable weight to the *intended use* recited in the claims. However, it should be pointed out that the MPEP (§2114) instructs that "features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure...." Thus, it is not enough that, as suggested by the Examiner's citation of Singer col. 6, lines 40-58, other systems check the identification of users for security purposes. Rather, the Examiner must demonstrate that systems having similar structure and therefore *having assessment questions* based on the intended use thereof (i.e., to check the requirements for the compliance certification) as recited in the claims is known or obvious, and not just that other systems are capable of providing some 'assessment questions' (Applicant further submits that checking identification is not equivalent to asking an assessment question) regarding some aspect of the organization.

B. The Examiner Failed to Make A *Prima Facie* Case of Anticipation As The Cited Prior Art Does Not Disclose, Teach or Suggest the "Assessment Questions," the "Requirements for At Least One Compliance Certification" and "Assessment Courses"

The Examiner asserts that Singer teaches the features of claims 1, 11 and 20; however, Applicant is confused by the Examiner's interpretation of the claims. The cited passages of Singer not only do not disclose or enable "assessment questions" distinct from evaluation questions, but also do not discuss "requirements for at least one compliance certification" and do not discuss "assessment courses" as recited in the claims. In the presently claimed subject matter, the evaluation questions are used to construct profile(s) for the organization(s) applying for certification and to determine the (types and number, etc. of) assessment courses that will be displayed for the user from the organization to complete. The assessment courses contain assessment questions that must be answered by the user. In contrast, the cited passages of Singer appear only to allow for the governmental responsible certification official to access a screen 212 to review one or more of the (application(s) for) permits. While Applicant recognizes that Singer provides for application of the "present invention" "to the creation, electronic certification... of any kind of permit document... for

electronic submission,” such a statement does not change the lack of disclosure or enablement in Singer of many features of Applicant’s claimed subject matter. None of the evaluation questions, assessment questions, assessment courses, or the requirements for certification recited in the present claims are disclosed in the above passages, instead only that *if* the official has reviewed the user’s (web forms and data spreadsheet) application *and* desires to certify the permit, electronic means are available for doing so.

The Examiner has asserted that “the reference database storing a plurality of evaluation question and plurality of assessment question” recited in the claims is disclosed by Singer as an “application server 16... [which] takes requests from users, accesses information needed by the users within the database 18 and sends that data to the web server 14 to be formatted into a web page... sent to the PC 12.” Applicant respectfully submitted, without response in the Advisory Action (contrary to MPEP 707.07(f)), that Singer fails to disclose or enable a “database storing a plurality of evaluation question and plurality of assessment question” as recited in the claims.

The Examiner has further asserted that “wherein the evaluation questions ask for information usable to construct profiles of at least one organization” recited in the claims, is disclosed by Singer as “the user accesses 302 the spread-sheet submittal web pages... page 264 the user enters 304 contact information, typically an address information including an e-mail address, enters 306 facility and equipment identification information in page 266 and enters 308 reporting period data in page 268... submits 310 the completed request to the application server 16 through the web server 14.” However, again, Singer fails to discuss evaluation questions. Instead, Singer’s submittal web pages merely consist of form fields for entering standard *contact* or *identification information*, similar to those that the applicant would ordinarily complete in paper form but instead, in Singer, completes in web form. Thus the ‘profile’ created in Singer is superficial at best and not derived from answers to evaluation questions, of which there are none. In contrast, the presently claimed subject matter refers to the development of profile(s) regarding the organization or laboratory being assessed for compliance. This is clearly supported in the original specification, especially at page 13. Thus, the specification reinforces the interactive relationship recited in the claims wherein evaluation questions are asked and the answers given by the user are used to construct a profile(s) for the organization or laboratory being assessed.

In further contrast, the Examiner has asserted that “wherein said processor is further

configured to construct at least one profile of the organization seeking said at least one compliance certification based on said responses to said subset of evaluation questions” is disclosed by Singer (Fig. 3Ci). As discussed above, Applicant respectfully submits that Singer fails to disclose or enable construction of “at least one profile of the organization... based on said responses to... evaluation questions” as substantially recited in the claims. Fig. 3Ci of Singer reinforces the points discussed above, as the figure depicts a screen shot of “Facility Profile” further explained by such text as “Your facility location address and mailing address are displayed” and “You may enter up to three contacts as your Facility Contacts.” No questions are present on the screen, and the profile that is suggested by this page is superficial, not directed to responses of evaluation questions regarding compliance criterion and could not be used to further determine the assessment questions to be asked for compliance certification, in contrast to the presently claimed subject matter.

In the Advisory Action, the Examiner stated that “the Singer reference provides a teaching of a list question that specifies the type of the facilities (...addresses, “facility and equipment information)” and argued that “claim language...do not specify the depth or the type of information in the evaluation survey.” However, this reliance on “depth or type of information” and focus on Applicant’s use of the term “superficial,” further reinforces the Examiner’s misunderstanding of Applicant’s claimed subject matter. Applicant’s claims clearly recite the questions, requirements and courses necessary to facilitate judgment of compliance certification in the claimed system.

Finally, lines 28-38 of Singer state that “[B]ecause the preparation of the *spread-sheet* can take a short period of time, the spread-sheet can be and typically is prepared at the server level and is “*off-line*” from the user’s interaction taking place with the permitting system web site on the client machine. As a result, when the user submits the request, the user need not wait for the spread-sheet to be created and can do other things... it is also possible for the user to wait and refresh the application screens in real-time...” Thus, not only does Singer merely produce a spreadsheet for data entry, but there is no interaction or enablement of interaction between the user, the server and the resulting spread-sheet in constructing a profile from the user’s answers to evaluation questions. In the Advisory Action, the Examiner asserted that Singer allowing brief period of offline interaction does not necessarily mean that the whole process takes place offline and pointed “also to interaction between the user, the server and the resulting spreadsheet in constructing a profile from the user’s answers.” Applicant respectfully submits that Singer’s disclosure of editing/uploading spreadsheets

and a central repository is not responsive to evaluation questions as recited in the present claims.

Applicant submits that claims 1, 11 and 22 and their respective dependent claims are allowable for at least the reasons stated above. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection and allow the pending claims to proceed to grant.

2. Rejection of claims 2-7, 9, 10, 12, 13, 18-20, 24 and 27 under 35 U.S.C. § 103(a)

Applicant appeals the final rejections of claims 2-7, 9, 10, 12, 13, 18-20, 24 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Singer in view of Bua ("Bua"), Fletcher et al. ("Fletcher") and Allison ("Allison"). Claims 2-7, 9, 10, 12, 13, 18-20, 24 and 27 depend from claim 1, 11 or 22 and the secondary references fail to cure the deficiencies of Singer noted above. As such, the rejections are clearly improper and Applicant respectfully requests that the Examiner reconsider and withdraw these rejections and allow the pending claims to proceed to grant.

CONCLUSION

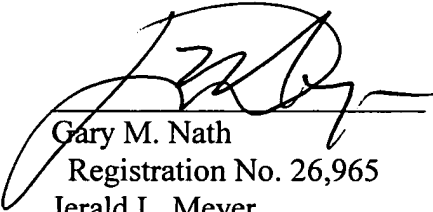
For the aforementioned reasons, the rejections of record are clearly improper and as such, should be immediately withdrawn. Accordingly, Applicant requests that the USPTO reconsider and withdraw these rejections so that Applicant does not have to devote the time and resources necessary to continue with the Appeal process.

If the Examiners have any questions or wish to discuss this matter, they are welcomed to telephone the undersigned attorney. Prompt and favorable consideration of this Request is respectfully requested.

Respectfully submitted,
THE NATH LAW GROUP

April 1, 2008

THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314-2891
Tel: (703) 548-6284
Fax: (703) 683-8396


Gary M. Nath
Registration No. 26,965
Jerald L. Meyer
Registration No. 41,194
Jiaxiao Zhang
Registration No. 63,235
Customer No. 20529